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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,290	04/08/2004	Phillipp Tanner	SCHWP0150USA	8614

7590

09/22/2004

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EXAMINER

LACYK, JOHN P

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,290

Applicant(s)

TANNER ET AL.

Examiner

John P Lacyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/8/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mann et al in view of Abrams et al.

Mann et al teaches an electromagnetic emitter for communicating with an implanted device. There is a marker made of VELCRO attached to the skin of the head that aids a user in properly placing the emitter for optimal coupling with the implanted device. Such an electromagnetic emitter would be capable of stimulation.

In the alternative, Abrams et al teach a device for the magnetic stimulation of the brain to treat psychiatric illness without causing seizures. Specific areas of the brain may be stimulated through exacting placement of the coils. Abrams et al fail to teach the use of markers to place the coils. Mann et al teach the use of markers, as discussed above. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the markers of Mann et al with the device of Abrams et al,

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as both involve the emission of electromagnetic waves into the head, Mann et al providing one solution to the problem of proper direction to a target, which is clearly important to Abrams et al as noted above.

4. Claims 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Mann et al and Abrams et al as applied to claims above, and further in view of He.

Abrams et al teach that in one embodiment, the device may be placed in a Dewar container and run on a track. Abrams et al teach that it is well known to map the brain. However, the specific type of simulation claimed is not taught by Abrams et al. He teaches a method and apparatus of biosignal spatial analysis. He teaches that a 3-shell model is constructed, and brain signals can be simulated on it and displayed on a monitor and that a control arm is used. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the simulator of He with the device of Abrams et al, as Abrams et al teaches that mapping of the brain is well known and He states that it is important to provide spatial information regarding bioelectrical activities. From these two, it would have been obvious to one skilled in the art to use the device of He to simulate the brain and use the simulations to guide the stimulations of Abrams et al.

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5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Mann et al and Abrams et al as applied to claim 1 above, and further in view of Edrich et al.

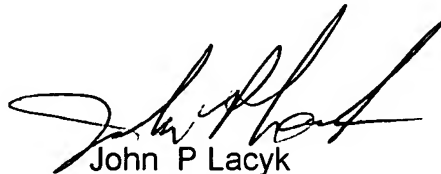
The combination of Mann et al and Abrams et al teaches all of the limitations of the claimed device except the specific use of a "figure eight" coil. Edrich et al teach that it is well known that figure eight coils provide superior performance to simple circular coils (column2, lines 34-38). Therefore a modification to us a figure eight coil in the device above would have been obvious to one of ordinary skill in the art in view of the teachings of Edrich et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P Lacyk whose telephone number is 703-308-2995.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P Lacyk
Primary Examiner
Art Unit 3736

J.P. Lacyk